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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,529	08/30/1999	BRIAN SHUSTER	SHUS805	1497

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BRULL PICCIONELLI SARNO & BRAUN  
1925 CENTURY PARK EAST  
SUITE 2350  
LOS ANGELES, CA 90067

EXAMINER

CHOUDHARY, ANITA

ART UNIT PAPER NUMBER

2153

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/386,529

Applicant(s)

SHUSTER ET AL.

Examiner

Anita Choudhary

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08/30/1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/30/1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

This is a Second Non Final Rejection Office Action in response to Applicants amendments and request for reconsiderations filed on August 8, 2002. Claims 1-9 are presented for further examination. Claim rejections based on 35 USC § 112 have been withdrawn in response to Applicants Amendments.

### ***Drawings***

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claim 8 and 9 rejected under 35 U.S.C. 102(e) as being anticipated by Broadhurst.

Broadhurst discloses a method for determining availability and registering proposed domain names. The domain hosting system disclosed in claim 8 is anticipated by the system disclosed by Broadhurst. Broadhurst discloses the points below in a domain naming system similar to that of claim 8.

In referring to claim 8, Broadhurst shows:

- Identifying a computer address of a requested domain name determined by second and top level of domain name requested (page 2 first and second paragraphs; page 5-6)
- Parsing procedure wherein subdomain name being second and top level and client name being third level (page 2 first and second paragraphs; page 5-6).
- Identifying a second computer address for defining subdomain (page 5-6).
- Transmitting results to user (fig. 7).

The domain management system claimed in claim 9 is also anticipated by the system disclosed by Broadhurst. Both systems assign domain names according to availability determined by system components including those stated below.

In referring to claim 9, Broadhurst also discloses a name assignment and hosting system having a scheduler (fig. 3 item 322), a query server or redirector (fig. 2 item 104), and storage device (fig. 3 item 320,330). The parser translates the domain requests to the DNS (providers) (see section. System Components page 4-7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 1, and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Report on Electronic Commerce” in view of “Mail.com”.

The “Report on Electronic Commerce” herein referred to as Report, shows substantial features of the claimed inventions including the following located in page 1 lines 35-44:

- A provider component of a domain name provided by owner of registration
- A user component of a domain name provided by local user of the registration.
- The user component of a domain name being third and fourth level domain names.
- The full domain name having user component followed by provider component.

Although the Report discloses the above, it fails to disclose the “selecting” of a provider component and client component and determination of whether the proposed name is to be assigned. Nonetheless this feature is well known and would have an obvious modification to the Report, as evidenced by services offered by “Mail.com.”

Mail.com offers a service of selecting from a plurality of second level and top-level domain name components and selecting a user component or username together to be assigned. Even though Mail.com discloses e-mail addresses the concept of selecting a provider component and user component is the same.

Given the service offered by Mail.com, a person of ordinary skill in the art would have readily recognized the advantages of modifying the Report by being able to select and assign names, as evidenced by the services of Mail.com, in order to provide a user with a simple way of obtaining domain names and for commercial purposes.

In referring to claim 3 and 4, Report shows four levels in the full domain name, provider component and client having a plurality of name levels. It is well known for provider to have more than two name levels. And it is well known for client to have more than two name levels by allowing user to choose from a list of top-level domain, the user can add more than two name levels to the left.

In referring to claim 6, the Report shows the fourth level to be chosen by user as discussed above (page 1 lines 35-44).

2. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Report on Electronic Commerce" in view of "Mail.com" and in further view of Broadhurst.

Although the combined teachings of the Report in view of Mail.com shows substantial features of the claimed invention, as discussed above, it fails to disclose determining the availability of a proposed name. Nonetheless, this feature is well known in the art and would have been an obvious modification to the Report in view of Mail.com as evidenced by Broadhurst.

Broadhurst discloses a method for determining unavailability of domain names in order to verify availability of a proposed name. Broadhurst takes client request and finds availability of the proposed name. (page 7-9 fig. 7).

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Given the method disclosed by Broadhurst a person having ordinary skill in the art would have readily recognized the advantages and desirability of modifying the Report in view of Mail.com, by having the system check for availability of a proposed name, in order that no two names are duplicated causing conflict of ownership of the name.

In referring to claim 7, the proposed name is held in data store of a specified domain name server (page 9 last two full paragraphs).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita Choudhary whose telephone number is (703) 305-5268. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

AC  
October 21, 2002



Dung C. Dinh  
Primary Examiner